

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patentees:	Liverton, et al.		
Patent No.:	U.S. Patent No. 7,592,360		
Issue Date:	September 22, 2009		
Serial No.:	10/559,153	Case No.:	21414
§ 371 Date:	December 5, 2005		
For:	3-FLUORO-PIPERIDINES AS NMDA/NR2B ANTAGONISTS		

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT PERIOD

UNDER 37 C.F.R. § 1.705 (d)

Sir or Madam:

Pursuant to 37 C.F.R. § 1.705(d), patentees hereby request reconsideration of the PTO's determination of 534 days of patent term adjustment (PTA) for the above-referenced patent. Patentees respectfully submit that they are entitled to an additional period of 291 days under 37 C.F.R. § 1.702(a)(4), for a total adjustment period of 825 days, because of the PTO's failure to issue the granted patent within three years of pendency.

This patent was granted September 22, 2009. The PTO acknowledged on the face of the patent that the patentee is entitled to a 534 day period of patent term adjustment. According to the PAIR records, the adjustment period is due to the failure of the PTO to issue an office action within fourteen months of filing, under 35 U.S.C. § 154(b)(1)(A). The actual filing date of this application in the United States was December 5, 2005. The PTO issued a first office action (a restriction requirement) on August 22, 2008, 564 days after the 14-month date. The 564 day period was reduced by 30 days under 35 U.S.C. § 154(b)(1)(C), for patentees' failure to timely respond to the November 21, 2008 office action. Accordingly, the patent was accorded 534 days of adjustment.

Patentees now assert that they are entitled to an additional 291 day adjustment period, under 35 U.S.C. § 154(b)(1)(B). Section 154(b)(1)(B) provides that patentees are entitled to a term adjustment "if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to

issue a patent within 3 years after the actual filing date of the application in the United States." The actual filing date of this application in the United States was December 5, 2005, when the requirements of 35 U.S.C. § 371 were met. Accordingly, the application should have been issued on December 5, 2008. This patent issued September 22, 2009, and thus the pendency period was 3 years and 291 days. The period from December 5, 2008 to September 22, 2009 is 291 days. Patentees should therefore be entitled to an additional 291 day patent term adjustment, and should be accorded a total of 825 days of adjustment.

Patentees acknowledge that the PTO has taken the position in 2004 that patent term adjustment may be obtained under 35 U.S.C. § 154(b)(1)(A), or under 35 U.S.C. § 154(b)(1)(B), but not under both §§ 154(b)(1)(A) and (B). However, under the decision of the United States District Court for the District of Columbia, in *Wyeth v. Dudas*, 2008 U.S. Dist. LEXIS 76063 (U.S. Dist. D.C. Sept. 30, 2008), any delay under section 154(b)(1)(B) for a pendency of more than three years is granted in addition to any delay under section 154(b)(1)(A). As a result, under the district court decision patentees are entitled to both the aforementioned 291 day period under § 154(b)(1)(A) and the 534 day period under § 154(b)(1)(B). Hence, it is submitted that patentees are entitled to an additional 291 days of patent term adjustment, for a total of 825 days of patent term adjustment.

Patentees note that *Wyeth v Dudas* is currently on appeal to the U.S. Court of Appeals for the Federal Circuit. Patentees respectfully request that the U.S. PTO hold in abeyance any decision regarding the section 154(b)(1)(B) patent term adjustment, until such time as the issue is resolved by the Court of Appeals.

Please charge the fee due for this request (\$200.00 – 37 C.F.R. § 1.18(e)) to Merck Deposit Account No. 13-2755. Kindly charge any deficiencies or credit any overpayment to Deposit Account No. 13-2755.

Favorable action is earnestly solicited.

Respectfully submitted,

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